

REMARKS

This responds to the Office Action dated September 21, 2005, and the references cited therewith.

Claims 1, 2, and 9 are amended. Claims 1-12, 36-46, and 52-55 are pending in this application.

§103 Rejection of the Claims

Claims 1-7, 9-12 and 39-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rorvick et al. (U.S. Patent No. 6,009,348) in view of Funari (U.S. Patent No. 4,171,477) or Hancock et al. (GB 825900). Applicant notes that the Office Action states that claims 1-7, 9-12 and 36-46 are rejected. Applicant believes this is an inadvertent error since the Office Action later states that claims 36-38 are allowed. Accordingly, Applicant is responding only to the rejection of claims 1-7, 9-12 and 39-46.

Claims 1-7

Applicant has amended claim 1 to better describe the subject matter recited in the claim. Applicant believes claim 1 is not obvious in view of the cited references since there is no motivation to modify or combine the cited references as required to support a 35 U.S.C. § 103(a) rejection.

Claim 1 now recites: A method of joining a connection member to a foil, the method comprising: positioning the connection member and the foil against each other, and forming a cold weld between the connection member and the foil by forcing the connection member and the foil together between a hardened surface and a staking pin which has a tip of less than or equal to approximately 0.030" (0.762 mm) in diameter.

As discussed previously, Funari discusses an electrical welder for bonding a wire to a substrate. (Abstract, Funari). Funari does not discuss joining using staking pins. Accordingly, regardless of the size of the Funari electrical welding tips, Funari does not discuss anything to do with forming a cold weld between the connection member and the foil. Applicant notes that, in Funari, electrical welding tips are "moved down into contact with the wire" before the circuit is discharged to bond the wire to the substrate. (Col. 7, line 27). This mere contact is not forming a cold weld, as recited in the claim.

Moreover, the Hancock reference also does not discuss the size of the tool 40, 42 discussed in the Hancock reference. The Office Action refers to the Figures and the text for this subject matter. However, the text describes the size of the foils as less than .001 inches. (Page 1, line 18). However, the Figures of Hancock are not necessarily drawn to scale and Applicant cannot ascertain the size of tools 40, 42.

Also, as discussed previously, a factor cutting against a finding of motivation to modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); *In re Spinnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963).

In this case, Rorvick et al. relates a welding technique to minimize the “overall thickness of anode sub-assembly 170 in the regions of welds 205 and 210.” (Col. 25, lines 38-39). Rorvick et al. state that in a preferred embodiment, the cold weld pins “have a diameter of about 0.060 inches.” (Col. 25, line 25). Rorvick et al. then state that “no or an inappreciable net increase in anode sub-assembly 170 thickness results when cold weld geometries and formation processes are appropriately optimized.” (Col 25, lines 52-54). Applicant believes this teaches away from modifying the geometry of the 0.060" weld pins of Rorvick et al. Applicant notes that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01. Accordingly, one skilled in the art would not be motivated to make the asserted modification.

Claims 2-7 include each limitation of their parent claim and are therefore also not obvious in view of the cited references. Reconsideration and allowance is respectfully requested.

Claims 9-12

Applicant has amended claim 9 to better describe the subject matter recited in the claim. Applicant believes claim 9 is not obvious in view of the cited references since there is no

motivation to modify or combine the cited references as required to support a 35 U.S.C. § 103(a) rejection, and even if combined, the combination does not include each limitation recited in the claim. For instance, Applicant cannot find in any cited

reference: placing the connection member physically against a hardened surface, placing the foil between the connection member and a staking tool, and forcing the foil into the connection member with the staking tool using enough force to create a cold weld between the connection member and the foil, as recited in claim 9.

Claim 10-12 include each limitation of their parent claim and are therefore also not obvious in view of the cited references. Reconsideration and allowance is respectfully requested.

Claims 39-46

Applicant traverses the obviousness rejection of claims 39-46 since the Office Action has not provided sufficient motivation to modify or combine the cited references as required to support a 35 U.S.C. § 103(a) rejection.

Claim 39 recites: A method of joining two or more foils, the method comprising: positioning the two or more foils in a stack; and forcing the two or more foils together between a hardened surface and a staking pin which has a tip of less than approximately 0.060" (1.524 mm) in diameter.

As noted above, Funari discusses an electrical welder for bonding a wire to a substrate. Funari does not discuss joining using a staking pin. Accordingly, regardless of the size of the Funari electrical welding tips, Funari does not discuss anything to do with tips of a staking pin. Also, Applicant notes that the size of tools 40, 42 of the Hancock reference cannot be ascertained from the reference itself. Accordingly, none of the references disclose staking pins of the size recited in the claim.

Again, there is no motivation in the art to modify the Rorvick reference. As noted above, Rorvick et al. relates a welding technique to minimize the "overall thickness of anode sub-assembly 170 in the regions of welds 205 and 210." (Col. 25, lines 38-39). Rorvick et al. state that in a preferred embodiment, the cold weld pins "have a diameter of about 0.060 inches." (Col. 25, line 25). Rorvick et al. then state that "no or an inappreciable net increase in anode sub-assembly 170 thickness results when cold weld geometries and formation processes are

appropriately optimized.” (Col 25, lines 52-54). Applicant believes this teaches away from modifying the geometry of the 0.060" weld pins of Rorvick et al. Applicant notes that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01. Accordingly, one skilled in the art would not be motivated to make the asserted modification.

Claims 40-46 include each limitation of their parent claim and are therefore also not obvious in view of the cited references. Reconsideration and allowance is respectfully requested.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rorvick et al. (U.S. Patent No. 6,009,348) in view of Funari (U.S. Patent No. 4,171,477) or Hancock et al. (GB 825900) as applied above, and further in view of Strange et al. (U.S. Patent No. 6,299,752).

Claims 8 and 54 include each limitation of their respective parent claims and are not obvious in view of the cited references for the reasons given above for their parent claims since the secondary reference does not overcome the deficiencies of the primary references discussed above. Reconsideration and allowance is respectfully requested.

Allowable Subject Matter

Applicant acknowledges the allowance of claims 36-38 and 52-55.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21 day of December, 2005.

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